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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,395	06/24/2005	David Chow	285-237 PCT US	9017

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DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER

WOODALL, NICHOLAS W

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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05/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,395	Applicant(s) CHOW ET AL.	
	Examiner Nicholas Woodall	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 2-21, 24-35 and 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 22, 23 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/29/2008 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 22, 23, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by McKinney (U.S. Patent 5,167,665).

Regarding claim 1, McKinney discloses a device comprising a first portion (19) capable of extending through multiple bone fragments and a second portion (23 and 39) capable of being displaced relative to the first portion and capable of being detachably coupled therewith in a locked position to secure bone fragments. McKinney discloses a

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device wherein the first portion includes a curved cylindrical body. The examiner is interpreting the first portion of the device includes a curved surface (33) on the cylindrical body, which the examiner believes read on the curved cylindrical body limitation of claim 1. The examiner notes that reference number 33 designates the head of the body of the device, but the examiner is using the reference number to direct the applicant to the area of the first portion having the curved surface. McKinney discloses a device wherein the second portion of the device includes a curved cylindrical body, wherein the cylindrical body of the second body is slidingly disposed within and extending substantially throughout the cylindrical body of the first portion. The examiner is interpreting the second portion of the device includes a curved surface (39), which the examiner believes read on the curved body limitation of claim 1. The examiner notes that reference number 39 designates the bead of the mandrel of the device, but the examiner is using the reference number to direct the applicant to the area of the second portion having the curved surface. Therefore, the first portion and the second portion are cylindrical bodies having a curved surface, i.e. a curved cylindrical body. The cylindrical body of the second portion extends substantially throughout the cylindrical body of the first portion. Regarding claim 22, McKinney discloses a device wherein the distal end of the second portion is enlarged to abut a distal end of the cylindrical body of the first portion. Regarding claim 23, McKinney discloses a device wherein a proximal end of the cylindrical body of the first portion has an enlarged head abutting an outer surface of a bone fragment in the locked position, wherein the distal end of the first body is capable of being forced outwards to abut an outer surface of another bone fragment

in response to a tensile force applied to a proximal end of the second portion.

Regarding claim 36, McKinney discloses a device inherently capable of being used by a method comprising the steps of displacing a first portion of the device through one of the bone fragments, displacing a second portion of the device through and within the first portion such that an enlarged distal end of the second portion abuts a distal end of the first portion so as to engage the first and second portions of the device, and displacing the first and second engaged portions relative to one another to a locked position, wherein the bone fragments are secured by the locked in fastener, wherein each of the first and second portions have a curved cylindrical body and wherein the cylindrical body of the second portion is slidingly disposed within and extending substantially throughout the cylindrical body of the first portion.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

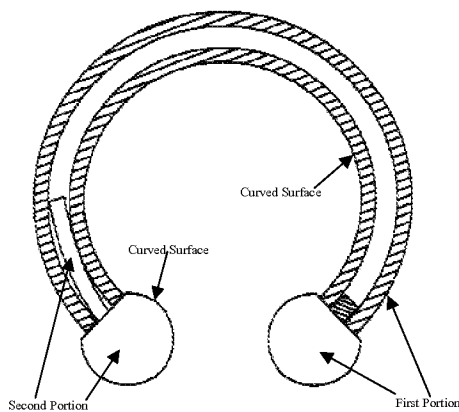
5. Claims 1, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siekierski (U.S. Patent 6,470,709).

Regarding claim 1, Siekierski discloses a device comprising a first portion capable of extending through multiple bone fragments and a second portion capable of being displaced relative to the first portion and capable of being detachably coupled therewith in a locked position to secure multiple bone fragments (see Figure 1 below).

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Siekierski discloses a device wherein the first portion includes a curved cylindrical body. The examiner is interpreting the cylindrical body of the first portion having a curved surface, which the examiner believes read on the limitations of claim 1. Siekierski discloses a device wherein the second portion includes a curved cylindrical body, wherein the cylindrical body is slidingly disposed within and extending through the curved cylindrical body of the first portion. The examiner is interpreting the cylindrical body of the second portion having a curved surface, which the examiner believes read on the limitations of claim 1. Regarding claim 22, Siekierski discloses a device wherein a distal end of the second portion being enlarged to abut a distal end of the cylindrical body of the first portion. Regarding claim 23, Siekierski discloses a device wherein the proximal end of the cylindrical body of the first portion has an enlarged head capable of abutting an outer surface of bone fragments and wherein the distal end of the first body is capable of being forced outwards to abut an outer surface of another bone fragment in response to a tensile force applied to a proximal end of the second portion. Siekierski discloses the invention as claimed except for the curved cylindrical body of the second portion extending substantially throughout the curved cylindrical body of the first portion. The examiner would like to note, the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984).

Figure 1



Response to Arguments

Applicant's arguments filed 02/29/2008 have been fully considered but they are not persuasive. The applicant's argument that Siekierski does not disclose the invention as claimed is moot. The examiner does not agree that Siekierski does not disclose a second portion having a curved cylindrical body extending substantially throughout the curved cylindrical body of the first portion. The term "substantially" is an extremely broad term and does not specify any direct limitation to the claim. However, in order to move prosecution of the application forward the examiner has provided new grounds of rejection to show that the Federal Circuit has held that a change in proportional size would have been obvious to one having ordinary skill in the art as long as the change in size would not change the functionality of the device. The applicant's argument that McKinney does disclose the invention of claim 1 is not persuasive. As discussed above, the first portion of McKinney includes a cylindrical body having at least one curved surface, which is being interpreted by the examiner as a curved cylindrical body, and the second portion includes a cylindrical body having at least one curved surface, which is being interpreted by the examiner as a curved cylindrical body. McKinney further

discloses that the cylindrical body of the second portion is slidably disposed and extends substantially throughout the cylindrical body of the first portion. Therefore, the examiner believes that McKinney discloses the invention as claimed. The applicant's argument that McKinney does not disclose the invention of claim 36 is not persuasive. McKinney discloses a bone fastener including a first portion and a second portion as discussed above. The first portion is placed through a bone fragment and the second portion is displaced through the first portion such that an enlarged end of the second portion abuts a distal end of the first portion. The first and second portions are then displaced to lock them together securing the bone fragments. Therefore, the examiner believes that McKinney discloses the invention as claimed.

Conclusion

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Examiner, Art Unit 3733
/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733